

REMARKS

Claim 39 has been amended to remove the objected-to phrase regarding R⁴ taken together to form a bridge. It is also amended to correct an inadvertent error whereby “alkenyl” and “alkynyl” are defined as possibly including only 1C – a situation that is obviously impossible. With that correction, claim 39 exactly parallels amended claim 1 as allowed in the parent application U.S. Serial No. 09/316,761 except that the linking heterocycle is a piperidine rather than a piperazine ring. The remainder of the claim is identical to claim 1 as amended in the parent case.

As the amended claim was considered fully supported by the original specification and original claims and as piperidine embodiments are clearly included in the parent case (but were removed by a restriction requirement) it is respectfully submitted that the present claims are supported by this case, filed 21 May 1999, as well.

Claims 40-53, as presently proposed, correspond to allowed claims 2-14 of the parent case (again, with the exception that the piperidine embodiment is substituted for piperazine in this case) and claim 58 corresponds to claim 17. The list of compounds in claims 72 and 73 is derived from the examples.

Claims 54-55 have been canceled and support for claims 56 and 57 is found in many examples – *e.g.*, Examples 7 and 8 where the piperidine ring is unsubstituted. Support for claims 60-63 is found, for example, in preparations E and F on pages 57 and 58 and G-K on pages 58-60. Claims 64-71 are also supported in these examples.

Thus, the entire subject matter of the claims is supported by the correct specification filed 21 May 1999 and submitted herewith.

The Rejections

Turning, now, to the specific grounds for rejection set forth, applicants respond as follows:

Claims 63 and 68-71 were rejected under 35 U.S.C. § 112, second paragraph, on the basis that the term “comprising” renders the claim indefinite. The Office states that the term is improper in a Markush format. This is a correct statement, but none of these claims is in a Markush format. There is no “selected from the group consisting of” language. The cited prohibition refers to an attempt to employ language such as “selected from the group comprising.” In the context of the present claims, “comprising” refers to a single substituent and simply means that the substituent includes this moiety. In order to avoid any further issues on this point, the claims have been amended accordingly. It is believed this basis for rejection may therefore be withdrawn.

Claims 39, 40, 42, 45-46, 49 and 60 were rejected under 35 U.S.C. § 112, second paragraph, on several bases which will be individually addressed.

First, the term “two R₄ taken together form a bridge optionally containing a heteroatom” has been deleted from the claims.

“CO or an isostere thereof” has also been deleted. “CH, CH₂ or an isostere thereof” has been modified in accordance with the substitute specification on page 5, lines 7-8 in combination with lines 12-14. However, it is noted that this phrase was not objected to in the allowed claims of the parent. In terms of the explanation for why this is indefinite, this is not seen as the isosteres are defined by the initial embodiment. In any case, this issue is moot.

The final phrase objected to “Y is optionally substituted alkyl, optionally substituted aryl or optionally substituted arylalkyl or two Y taken together may form an alkylene (2-3C) bridge” – again, this exact phrase appears in the allowed claims in the parent. The only portion of the phrase that actually seems objected to is an “alkylene (2-3C) bridge.” This seems perfectly clear - the bridge must either be –CH₂-CH₂- or –CH₂-CH₂-CH₂-. It is believed this phrase is clear. The bridge in CA 135 is not an alkylene, but an alkenylene and contains 4C.

The rejection of the claims under 35 U.S.C. § 112, first paragraph, is believed caused by the confusion generated by the erroneous filing of the great-grandparent application in place of the specification of the application of which this is a divisional. As the proper specification has now been filed (having been incorporated by reference in the original filing) it is believed that this basis for rejection is moot.

The comment concerning unpredictability of the art and not sharing p38 kinase activity with certain compounds published subsequent to the effective filing date herein is not understood - the fact that similar compounds have other biological activities does not exclude the possibility that they also inhibit p38 kinase.

Claims 39, 40, 42, 45-46, 49 and 60 were rejected as assertedly anticipated by CA 131:97650, CHEMCATS 2002:1367700 and CA 132:347492. It is believed this basis for rejection may be withdrawn in light of the substitute specification which clarifies that applicants are entitled to an effective filing date of 21 May 1999; all of these publications are subsequent to that date. In any event, it is noted with appreciation that claims 41, 43-44, 47-48, 50-53 and 56-59 as well as claims 61-78 are free of this rejection.

The above cited claims were also rejected as obvious over CA 135:313624. Not only does this document postdate the effective filing date, the compound set forth is excluded by virtue of the benzene ring fused to the piperidine ring as explained above. Accordingly, this basis for rejection may also be withdrawn.

Finally, claims 39-78 were rejected as obviousness-type double-patenting over the claims of U.S. patents 6,410,540; 6,448,257 and U.S. application 2002/0115671.

With regard to the two issued patents, there is no statutory double-patenting as there is no issued claim and no proposed claim that is of the same scope of the presently claimed subject matter. Terminal disclaimers with respect to all three documents are enclosed.

CONCLUSION

Applicants again apologize for the confusion caused by the original submission of the great-grandparent rather than the parent specification along with the Preliminary Amendment. This has now been corrected and it should be clear that applicants are entitled to an effective filing date at least as early as 21 May 1999. The claims have been amended to delete an objected-to phrase as unnecessary and other cosmetic amendments have been made.

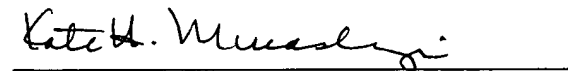
In view of the effective filing date, none of the cited documents are applicable to defeat patentability. Terminal disclaimers have been submitted with respect to co-owned issued patents and a co-owned application. It is therefore believed that all bases for rejection have been overcome and passage of the pending claims, claims 39-53 and 56-78 to issue is respectfully requested.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 219002028310.

Respectfully submitted,

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